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PATENT
Customer No. 22,852
Attorney Docket No. 02906.0346

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of: |) | |
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| Patrick R. Lancaster, III et al. |) | Group Art Unit: 3721 |
| |) | |
| Serial No.: 10/696,722 |) | Examiner: J. Paradiso |
| |) | |
| Filed: October 30, 2003 |) | Confirmation No.: 6330 |
| |) | |
| For: PALLET DISPENSER |) | |
| |) | |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement mailed on January 26, 2005, the Examiner required restriction under 35 U.S.C. § 121 between:

Group I, Claims 1-58, 76-89, and 133-136, characterized as being drawn to a method and apparatus for dispensing pallets utilizing a cantilevered pusher bar; and

Group II, Claims 59-75 and 90-132, characterized as being drawn to a method and apparatus for dispensing pallets.

Applicants provisionally elect to prosecute Group I, claims 1-58, 76-89, and 133-136. This election is made with traverse for the reasons set forth below.

In the Office Action, the claims of Groups I and II were restricted because, according to the Office Action, the claims of Group I require a cantilevered arm and the claims of Group II do not. See Office Action, page 2. In addition, the claims were

restricted because the search for Group I is allegedly not required for Group II. See Office Action, page 3.

Citing MPEP §§ 806.04 & 808.01, the Office Action suggests that the claims of Groups I and II are independent. See Office Action, page 2. However, for the claims of the invention to be independent, the claims must be directed to different combinations, not disclosed as capable of use together, having different modes of operation, or different functions or effects. See MPEP § 806.04. The MPEP continues with some examples of independent inventions. One example is an article of apparel, such as a shoe or necktie, and a locomotive bearing. See id.; § MPEP 808.01, Examiner Note. Another example is a process of painting a house and a process of boring a well. See MPEP § 806.04.

While the meaning of the terms used in the MPEP to define “independent” inventions may be vague, the examples provided for context are not. In order for the Groups of claims to be restricted as being directed to independent inventions, the claims must be directed to entirely and completely different subject matter. In fact, the MPEP explicitly states that independent inventions are “but rarely presented, since persons will seldom file an application containing disclosures of independent things.” See § MPEP 808.01. This suggests that independent inventions are entirely and absolutely exclusive of one another. This is not the case in the Groups of claims in the present application.

In contrast to the examples of independent inventions set forth in the MPEP, the claims of both Groups I and II in the present application are related to the same general invention. That is, the claims of both Groups I and II are directed toward a method and

apparatus for dispensing pallets. The subject matter of the claims of Groups I and II is not independent as would be a necktie and a locomotive bearing. Therefore, the claims are not independent as suggested in the Office Action.

In addition to requiring that the inventions of Groups I and II be independent of one another, a proper restriction would require that examination of both Groups of claims impose a serious burden on the Examiner. See MPEP § 803.01. A serious burden may be shown by appropriate explanation of separate classification or separate status in the art, or a different field of search. See id. Accordingly, even if the claims of Groups I and II were found to be independent as suggested in the Office Action, a restriction cannot be sustained unless the Examiner shows by appropriate explanation that, in addition to being independent, Groups I and II have one of the following elements: (A) separate classification; (B) separate status in the art; and (C) different field of search. See MPEP § 808.02. Where “the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” Id.

This same section of the MPEP defines the above-required elements as follows:

(A) Separate classification thereof: This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classifiable together: Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search. MPEP § 808.02.

First, Applicants submit that the Examiner has not established that the claims of Groups I and II have a separate classification, as set forth above in Element (A). The Office Action indicates that the claims of both Group I and Group II are classified in class 53. See Office Action, page 2. Accordingly, instead of being separate, the Office Action indicates that Groups I and II have the same classification. Because Groups I and II have the same classification, Element (A) requiring a separate classification is not met. Therefore, the claims of the application cannot be restricted based on the first element.

Element (B) required for proper restriction is present when the inventions have formed a separate status in the art. A separate status in the art may be shown by citing patents which are evidence of such a separate status, and also a separate field of search. See MPEP § 808.02. However, Applicants have not received any evidence that the inventions have formed a separate status in the art. The Office Action does not cite any patents as evidence showing any status of either of Groups I or II. Applicants submit that in the absence of such citations and evidence, it cannot be presumed that Groups I and II have formed a separate status in the art. Because the claims of Groups I and II have not formed a separate status in the art, evidenced by cited patents, Element (B) required for proper restriction is not present.

Finally, Element (C) required for proper restriction is present when the Groups require a different field of search. The Office Action states that a search for the claims of Group I is not required in a search for the claims of Group II. However, as defined in the MPEP, a different field of search exists only “[w]here it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists.” See MPEP § 808.02(c) (emphasis added). This requirement is not met. Instead, if the Examiner were to search the claims of Group II, the places searched would likely contain pertinent art to the claims of Group I. For example, the places searched for a method and apparatus for dispensing pallets would likely contain art pertinent to a method and apparatus for dispensing pallets, albeit utilizing a pusher bar.

In a similar manner, if the Examiner were to search the claims of Group I, the places searched would likely contain pertinent art to the claims of Group II. For example, the places searched for a method and apparatus for dispensing pallets utilizing a pusher bar would likely contain art pertinent to a method and apparatus for pushing pallets.

Additionally, as set forth above, the Office Action indicates that the classification is the same for both of Groups I and II. Therefore, there is nothing to suggest that the field of search would be different than the classification. Accordingly, the claims of Groups I and II do not require a separate field of search when considered in view of the MPEP.

In summary, based on the above, Applicants submit that the Examiner has not established that Groups I and II are independent or that Groups I and II possess a separate classification, a separate status in the art, or a different field of search. In

addition, Applicants submit that Groups I and II relate to the same general subject matter (e.g., methods and apparatus for dispensing pallets), have the same classification, have not attained a separate status in the art, and do not require different fields of search. "Where ... the classification is the same and the field of search is the same and there is not clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." See MPEP § 808.02 (emphasis added). Thus, Applicants contend that there is no reason to restrict the claims of Group I from the claims of Group II. Accordingly, Applicants request that the restriction requirement between Groups I and II be withdrawn and that the claims of both Groups I and II be examined on the merits in this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 28, 2005

By: 

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